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### REMARKS

Reconsideration of the above identified patent application is respectfully requested. Claims 1-14, 16-22 and 35 are pending. Claims 15-17 are canceled. Claim 35 is amended in order to more particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Claims 23-34 are withdrawn as being directed to non-elected inventions. Applicants respectfully traverse the rejections under 35 U.S.C. 112, 35 U.S.C. 102 and 35 U.S.C. 103.

#### I. Non-Art Issues

##### A. Specification

The amendment to the Specification, filed 8/12/04, is objected to under 35 U.S.C. 132 for allegedly introducing new matter. Applicants respectfully traverse this rejection as best understood from the Official Action.

It is asserted that the added material which is not supported by the original disclosure is "a new embodiment." Applicants respectfully submit that this is unclear, because no guidance is provided to identify this allegedly new embodiment. MPEP 706.03(o) notes that any new matter objection to the specification should "identify the new matter by page and the line numbers and/or drawing figures and provide an appropriate explanation," and that "This explanation should address any statement by applicant to support the position that the subject matter is described in the specification as filed. It should further include any unresolved questions which raise a doubt as to the possession of the claimed invention at the time of filing." In the present case, no page numbers, line numbers or drawing figures are identified as including

the alleged new matter. In addition, no explanation is provided to address Applicants' statements filed concurrently with the 8/12/04 amendment in support of the position that the amendment is described in the specification as filed. It is therefore unclear to Applicants as to how or which of the 8/15/04 amendments add new matter.

As best understood from the Official Action, Applicants' addition of either new Fig. 9 or new Fig. 10 or the brief descriptions thereof add an allegedly new embodiment to the present application. As stated above, support for these new drawings was identified in Applicants' 8/12/04 Response. Those statements are incorporated herein by reference. In short, Fig. 9 does not show a new embodiment – it merely illustrates a previously disclosed embodiment. Fig. 9 shows an embodiment of the uncoated stripe 42 extending through the uncoated knockouts 9 on panel 11. The original disclosure described and illustrated the uncoated stripe 42 extending through the punch scores 8 on panel 15, and stated that alternatively, the uncoated stripe 42 may be placed on the panel 11 extending through the knockouts 9. Fig. 9 was submitted at the Examiner's request to provide an illustration of this embodiment. Additional discussion of the uncoated stripe 42 is provided below.

Fig. 10 shows an additional view of the Fig. 4 embodiment, which was originally disclosed and illustrated. In particular, Fig. 10 shows a cross section of the panels 15 and 11, knockouts 9, punch scores 8, adhesive 55, and coating 56 according to the embodiment shown in Fig. 4. As described in Applicants' statements filed concurrently with the 8/12/05 amendments, each layer is not shown to scale, however, paperboard coatings and adhesives are well known, and a person skilled in the art would realize that this is necessary for identification of the

coatings and adhesive, which have a much smaller thickness than the paperboard. Applicants submit that an illustration depicting an alternative, representative view of an already disclosed embodiment is not a new embodiment.

B. Drawings – New Matter

The proposed drawings dated 1/15/04 have been disapproved for allegedly showing new matter. Applicants again respectfully traverse the drawing objections.

Figs. 9 and Fig. 10 were submitted in response to a request by the Examiner, which required corrected drawings showing the uncoated stripe going through the knock-outs; the adhesive in Fig. 1; and a cross sectional view through each of the knock-outs and punch scores. Accordingly, Fig. 9 was submitted to show an embodiment of the carton with the uncoated stripe 42 going through the knock-outs 9, and Fig. 10 was submitted to show a cross sectional view of the carton taken along a line through the knock-outs 9 and punch scores 8. Although specifically requested by the Examiner, Figs. 9 and 10 were subsequently disapproved for allegedly showing new matter.

Applicants submit that Figs. 9 and 10 are not necessary. In light of the written description and drawings provided in the original disclosure, combined with the knowledge of those skilled in the art, Applicants submit that the content of Figs. 9 and 10 is not essential for a proper understanding of the invention.

First, a drawing of the uncoated stripe going through the knockouts is not necessary because the uncoated stripe is clearly illustrated in the original drawings. For example, original Figs. 5, 6, and 8 show the uncoated stripe 42 extending through the punch

scores 8 on panel 15. The original disclosure clearly states that this uncoated stripe 42 could otherwise be placed on the panel 11, extending through the knockouts 9. Page 9, line 20-page 10, line 1. Original Fig. 8 further shows the uncoated stripe would align with both the punch scores 8 AND the knockouts 9 when the blank is folded into a carton.

Second, Applicants submit that it is not necessary to add a drawing of the adhesive in claim 1. As stated in the original disclosure, many types of paperboard adhesives are well known to those skilled in the art and can be applied in many different ways. The original disclosure further states that "It is known in the art that the adhesive used can be applied to the adhesive panel 15, right panel 11, or both as long as the adhesive will contact both the punch scores 8 and knock outs 9 when the appropriate panels are in contact." Page 6, lines 17-18; page 6 line 23 through page 7, line 1; page 10 lines 13-14.

Third, Applicants submit that a cross sectional view through each of the knock-outs and punch scores is not essential to a proper understanding of the invention. The relative thicknesses of paperboard cartons, adhesives and coatings are well known. Skilled artisans know that adhesives and coatings are typically applied to paperboard in very thin layers. Because they are so thin, virtually any cross sectional drawing showing the paperboard, adhesive and coating would need to be out of scale and potentially confusing. In support of this position, Applicants note that other U.S. Patents describing and claiming paperboard cartons and adhesives have issued without a cross sectional view. For example, U.S. Patent 3,281,054 to Buttery, cited in the Official Action, claims a blank for forming a carton wherein an adhesive is applied to affix two panels and yet does not include a cross sectional view.

Applicants further submit that, whether or not Figs. 9 and 10 are necessary, they are supported by the original disclosure. As stated above, Fig. 9 shows an uncoated stripe 42 extending through the knock-outs 9 on panel 11. It is asserted that the original disclosure does not support “the extent of portion 42, and the width of portion 42.” Applicants assume this assertion is made in reference to Fig. 9, and respectfully disagree with this assertion as applied to Fig. 9. The uncoated stripe 42 is first described in the original disclosure in reference to one embodiment of the invention, wherein the stripe 42 is located on the adhesive panel 15. Page 8, line 17 through page 9, line 3. The disclosure states that “the uncoated stripe 42 can be any length, but in the preferred embodiment the uncoated stripe 42 runs from the top end 16 to the bottom end 17 of the adhesive panel 15 through the center of the punch scores 8,” and that “the size (including both width and length) of the uncoated stripe 42 will affect the ease of opening the carton.” In addition, the original disclosure states at page 9, line 20 through page 10, line 1 that:

Although the uncoated stripe 42 was previously described as running through the punch scores 8 on the adhesive panel 15, it could alternatively run in a similar manner through the knock-outs 9 on the right panel 11. Regardless of which panel the uncoated stripe 42 is located on, if an uncoated stripe 42 is present it preferably runs through the center of the knock-outs 9 and punch scores 8. [As shown in original Fig. 8.]

Fig. 9 is simply an illustration of the uncoated stripe 42 in this alternative location, wherein the stripe 42 runs through the knock-outs 9 on right panel 11. In other words, Fig. 9 shows the same uncoated stripe 42 as shown in Figs. 5, 6, and 8, but it is moved from the adhesive panel 15 to the right panel 11.

Disapproved Fig. 10 shows a cross section of the carton along a line through the knock-outs and punch scores. It is asserted that “the thickness of portions 55, 56, 11, 15, and the dimension of portions 8 and 9 are not consistent with the disclosure.” Applicants respectfully disagree with this assertion as applied to Fig. 10. Each layer shown in Fig. 10 is either conventional or is described in detail in the original disclosure. As stated in Applicants’ remarks submitted in the Response filed 8/12/04, each layer of Fig. 10 is not shown to scale, however, a person skilled in the art would realize that this is necessary for identification of the coatings and adhesive, which have a much smaller thickness than the paperboard.

The original disclosure unquestionably provides support for the thickness of the adhesive panel 15 and the right panel 11, because the disclosure explicitly states that “the paperboard blank is manufactured from conventional paperboard materials having a thickness of approximately .010 to .024 inches,” and that “The specific paperboard will vary from application to application based primarily on the desired characteristics of the carton.” Page 6, lines 18-20.

The original disclosure also provides support for the coating 56 and adhesive 55. Coatings and adhesives are well known for application to paperboard cartons. Therefore, people of skill in the art are highly familiar with the thicknesses and dimensions of paperboard, coatings, and adhesives. The original disclosure states that the paperboard (comprising layers 11 and 15 of Fig. 10), coating (layer 56), and adhesive (layer 55) of the present invention are all conventional, that the coating is preferably a UV varnish, and that the adhesive is preferably a water-based adhesive. Page 6, lines 17-18; page 6 line 23 through page 7, line 1; page 10 lines 13-14.

The original disclosure further provides a detailed description of the respective dimensions of the knock-outs 9 and punch scores 8. With respect to the punch scores 8, the original disclosure states that “the punch scores 8 can be to almost any depth in the adhesive panel 15, but in the preferred embodiment the punch scores 8 penetrate approximately  $\frac{1}{2}$  the depth of the adhesive panel 15,” and that “in the illustrated embodiment, the punch scores 8 are circular, but they can be of nearly any shape,” and further that “The size of the punch scores 8 will vary from application to application, keeping in mind that, with typical paperboard [sic], adhesives and coatings, the punch scores make it easier to open the carton by facilitating separation between layers of the laminated paperboard.” Page 8, lines 5-12. With respect to the knock-outs 9, the disclosure states that the right panel has a number of uncoated portions or knock-outs, and that “the knock-outs 9 can be any size and shape, but are preferably approximately the same size and shape as the punch scores 8.”

C. Drawings – 37 C.F.R. 1.83(a) Objections

The drawings are also objected to for failing to show every feature of the invention specified in the claims. Specifically, it is asserted that the printed material in claim 1, the various coating materials, the adhesive in claim 1, the uncoated stripe going through the knockouts, and the coating on the panel having the punch scores in claim 3 must be shown.

Fig. 6 is amended to show an example of the printed material in claim 1. A new sheet is submitted with this Response including amended Fig. 6 and labeled “Replacement Sheet.” Fig. 4 is amended to show an example of the coating 56 on the panel 15 with the punch scores 8. A new sheet is submitted including amended Fig. 4 and labeled “Replacement Sheet.”

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For purposes of illustration, the coating 56 is shown only on the adhesive panel 15. As stated in the original disclosure, the entire rear surface of the blank may be coated. Page 7, line 2. No new matter has been entered.

The coating materials, adhesive in claim 1 and the uncoated stripe going through the knockouts are all shown in disapproved Figs. 9 and 10. As stated above, Applicants respectfully submit that 1) Figs. 9 and 10 are not necessary as these items are not essential to an understanding of the invention and 2) both Fig. 9 and Fig. 10 are supported by the original disclosure. Therefore, Applicants respectfully submit that, upon approval of Figs. 9 and 10, every feature of the claims, whether necessary or not, will be shown in the drawings.

D. Section 112 Rejections

Claims 1-14 and 18-22 are rejected under 35 U.S.C. 112 as failing to comply with the written description requirement. It is asserted that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully disagree.

Regarding claim 1, it is asserted that the original disclosure does not teach the knockouts as being defined by an absence of any coating material. The original disclosure states that "In the preferred embodiment, the back surface of the right panel 11 is coated and has a number of uncoated portions, or knock outs 9." Page 9, lines 7-9. Applicants respectfully submit that this statement clearly teaches that the knockouts may be defined by an absence of any coating.



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Regarding claim 14, it is asserted that the original disclosure does not teach the blank having an adhesive. The original disclosure states that “The adhesive is preferably applied in a line extending substantially along the entire length of the adhesive panel 15,” and that “the adhesive can be rolled onto the adhesive panel 15, and that “It is known in the art that the adhesive used can be applied to the adhesive panel 15, right panel 11, or both,” and finally that “Whatever method is used, the strip of adhesive applied preferably is applied from the top to the bottom of the appropriate panel through the punch scores 8 or knock outs 9.” Applicants respectfully submit that these statements clearly teach that the blank may have an adhesive.

Claims 3, 14 and 18-22 are rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

Regarding claim 3 it is asserted that it is unclear where the coating is on the first panel. Applicants submit that 1) amended Fig. 6 shows one example of where the coating may be located on the first panel and 2) the original disclosure states that both surfaces of the paperboard blank may be coated. Page 7, lines 1-2. It is respectfully submitted that this rejection is therefore overcome and/or should be withdrawn.

Regarding claim 14, it is asserted that the result of having a plurality of uncoated knockouts and an uncoated stripe extending through the knockouts on the same panel would result in one uncoated area. Applicants agree that the uncoated stripe extending through the knockouts would result in one uncoated region, but submit that the knockouts and the uncoated stripe continue to have individual characteristics that enable them to be recited separately.

## II. Invention Summary

As described in Applicants previous Responses, filed January 12, 2004 and August 12, 2004 and incorporated herein by reference, the present invention is directed to a folding carton construction that permits the carton to be easily unfolded while still maintaining sufficient strength to carry the desired contents. The carton may include various permutations of punch scores, knock-outs and adhesive, allowing a manufacturer to control the adhesive strength of the carton and at the same time decrease the likelihood of tearing of the interior surface of the carton. As described in independent claims 1 and 35, the carton includes both a contents access opening and a manufacturer's flap, wherein the various permutations of punch scores, knock-outs, adhesive and an uncoated stripe are located on the manufacturer's flap. As described in independent claim 14, the carton further includes an uncoated stripe extending through either of the punch scores or knockouts enabling additional control over the adhesive strength of the carton.

## III. Claims Not Rejected On the Basis of Prior Art

Applicants note with appreciation the fact that claims 4-13 and 21-22 have not been rejected on the basis of prior art. In view of the above remarks and the amendments filed herein with respect to the Non-Art Rejections, Applicants submit these claims are allowable.

## IV. Art Rejections

### A. Section 103 Rejection Based on Buttery '054

As previously presented, claims 14, 18 and 36 were rejected under 35 U.S.C. 103 as being unpatentable over U.S. Patent 3,281,054 to Buttery. Applicants point out that claim 36

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does not exist in the present application. It is therefore unclear which claims are the subject of this rejection. Applicants respectfully traverse the Section 103 rejection as applied to any of the claims.

Buttery discloses a carton blank having a contents access opening that is sealed by the attachment of two panels. Both panels are coated entirely with a release agent, except for a number of circular, uncoated regions. One panel is coated entirely with adhesive. The other panel includes a number of cut score lines that define the uncoated regions on that panel. The uncoated regions of each respective panel align such that adhesive on the first panel bonds with the uncoated areas outlined by cut score lines on the second panel. In order to gain access to the contents of the carton, a user may tear off the first panel and open the contents access opening.

With respect to independent claims 14 and 35, Buttery does not disclose, teach or suggest an uncoated stripe extending along the first panel or the second panel, the stripe being defined by an absence of coating and extending through either the knockouts or punch scores. Buttery teaches only that adhesion may be increased by adhering an adhesive panel directly to an uncoated region. Buttery does not teach or suggest controlling the adhesion between the two panels by adding an uncoated stripe extending along either of the panels.

Additionally, with respect to amended independent claim 35, Buttery does not disclose a series of coated and uncoated regions located on a manufacturer's joint. Buttery only teaches controlling adhesion on a contents access opening. The contents access opening and the manufacturer's joint are two different features that serve completely different functions. For example, the contents access opening is designed to be easily opened for providing access to the

contents of the carton. It does not secure the blank in a folded position, and does not permit unfolding the blank to provide access to the interior of the carton. Unlike the contents access opening, the manufacturer's joint must provide sufficient shear strength to keep the carton closed during shipping and storage, while still permitting the carton to be peeled open to flatten the carton and expose the interior surface. The present invention provides a manufacturer's joint that meets these requirements and also minimizes tearing on the interior surface of the carton.

B Section 103 Rejection Based on Thresher in view of Buttery '054

As previously presented, claims 11, 18 and 19 were rejected under 35 U.S.C. 103 as being unpatentable over Thresher in view of Buttery '054. Applicants respectfully traverse this rejection.

Thresher discloses a carton blank with a contents access flap wherein the adhesion of a first panel to a second panel includes applying adhesive to the first panel such that it will contact sealing areas defined by score lines on the second panel.

With respect to independent claims 14 and 35, Applicants submit that Thresher does not overcome the above noted inadequacies of Buttery '054. In short, Thresher does not teach a panel having coated portions and uncoated portions, let alone an uncoated stripe extending through a plurality of uncoated regions or a plurality of punch scores. In addition, with respect to claim 35, Thresher does not disclose or teach a series of coated or uncoated regions and adhesive on a manufacturer's flap.

C. Section 102 Rejection Based on Cassidy

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Claims 14 and 18-20 are rejected under 35 U.S.C. 102 on the basis of U.S. Patent 5,029,714 to Cassidy.

Cassidy was addressed in the previous two Responses, and those comments are incorporated herein by reference. Cassidy includes a contents access opening with two overlapping flaps that are sealed together. The two flaps are coated with a PET coating, further coated at a series of embossed regions, and additionally coated with an abseal coating in the areas between the embossed regions. The two flaps are joined together only at the embossed regions with an adhesive.

With respect to claim 14, Cassidy does not disclose a panel surface having a plurality of knock-outs that are defined by an absence of coating material. Both panels disclosed by Cassidy, including the white portions 50, are completely coated with a PET coating. Additional portions are then further coated with an embossment and an abseal. Quite to the contrary of the present invention, Cassidy attempts to control the adhesion between the panels by adding *additional* coatings to the already coated paperboard instead of uncoated regions. The present invention may provide advantages over Cassidy by not requiring the time and expense of these additional coatings. Additionally, Cassidy does not additionally disclose an uncoated stripe defined by an absence of coating.

D. Section 103 Rejection Based on Cassidy in View of Kienlen

Claim 36 is rejected under 35 U.S.C. 103 as being unpatentable over Cassidy in view of U.S. Patent 2,259,822 to Kienlen. Applicant assumes that this rejection was directed at independent claim 35, and will address the rejection as such.

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Kienlen discloses a carton with a contents access opening including a first panel having a strip of adhesive, and a second panel having an adhesive resistant coating except for a number of regions that are left uncoated. When the panels are joined together, the adhesive on the first panel adheres only to the uncoated regions on the second panel.

With respect to independent claim 35, neither Kienlen nor Cassidy disclose or teach 1) a first panel having a plurality of punch scores and a second panel having a plurality of uncoated knockouts, wherein a strip of adhesive is applied between the knockouts and punch scores, or 2) a carton having both a contents access opening and a manufacturer's flap, wherein a plurality of coated and uncoated required located on the manufacturer's flap. Both Kienlen and Cassidy teach variations of adhesive regions and abseal regions on a contents access flap. There is absolutely no teaching in either reference of a manufacturer's flap meeting the characteristics described above with regard to the manufacturer's flap of the present invention, let alone a teaching of a plurality of punch scores and knockouts on the manufacturer's flap.

E. Section 103 Rejection Based on Buttery '054 in view of Buttery '059 and Hopwood

Claims 1-3 are rejected under 35 U.S.C. 103 on the basis of Buttery ('054) in view of U.S. Patent 3,281,059 to Buttery and further in view of U.S. Patent 4,643,315 to Hopwood.

Buttery '059 is similar to Buttery '054 discussed above, except that Buttery '059 discloses a contents access opening that includes a plurality of secondary cut scores inside or

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adjacent to the circular cut score regions disclosed in Buttery '054. In addition, the uncoated regions may be surrounded by an adhesive resistant ink.

Hopwood discloses a carton for holding film cassettes with a contents access flap that may be opened by tearing along perforations to access the contents of the carton and reveal printed material on the interior of the carton.

With respect to independent claim 1, none of the references, either alone or in combination, disclose a carton having both a contents access flap and a manufacturer's joint, wherein the manufacturer's joint includes a plurality of coated and uncoated regions and a plurality of punch scores aligned with the uncoated regions to control the adhesive strength of the manufacturer's flap. As discussed above, the manufacturer's joint and the contents access flap are completely different aspects of a folding carton. Manufacturer's joints are required to perform functions that are not required of contents access flaps, such as having sufficient shear strength to hold the carton together during shipping. As further discussed above, the present invention meets these requirements, while controlling the strength of adhesion and also minimizing tearing on the interior surface of the carton. In contrast, Hopwood teaches away from the present invention by teaching that the interior of a carton should be accessed by actually tearing the carton.

F. Section 103 Rejection Based on Struble in view of Buttery '054 or Buttery '059

Claims 1, 2, 3 and 35 are rejected under 35 U.S.C. 103 as being unpatentable over U.S. Patent 3,187,976 to Struble in view of Buttery ('054) or Buttery ('059).

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Struble discloses a carton that can be converted to a product display tray by removing a portion of the carton. The removable portion is connected to the tray by a plurality of adhesive portions that align with a plurality of punch scores. The contents of the carton are accessed by removing the removable portion, such that the product remains in the display tray. The carton includes foldable end flaps that seal the ends of the carton, but these flaps cannot be used to access the contents of the carton because the ends of the tray block the openings when the foldable flaps are opened.

With respect to independent claims 1 and 35, none of the references disclose a carton having both a contents access flap and a manufacturer's joint. As discussed above, the Buttery references and Struble only teach uncoated and coated regions and adhesives on a contents access opening. Manufacturer's flaps must meet different requirements and serve completely different functions than contents access openings. Nothing in the references even mentions the differences between the two, let alone teaching or suggesting the manufacturer's flap of the present invention.

#### V. Dependent Claims

The dependent claims further define Applicants' invention and are therefore even more clearly allowable. Claim 2 further recites the carton of claim 1 having an uncoated stripe running through the knock-outs on the second panel. Claim 3 further recites a coating material on the surface of the first panel. Claim 18 further recites that the punch scores penetrate approximately  $\frac{1}{2}$  the thickness of the second panel. Claim 19 further recites that the first panel is an adhesive panel and the second panel is a right panel.



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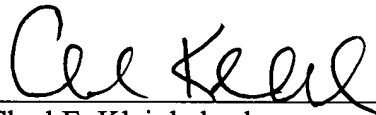
VI. Conclusion

In view of the above amendments and these remarks, Applicants respectfully submit that the present application is in condition for allowance. A notice to that effect is earnestly and respectfully requested.

Respectfully submitted,

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By: Warner Norcross & Judd LLP

A handwritten signature in cursive script, appearing to read "Chad E. Kleinheksel", is written over a horizontal line.

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